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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/350,393 07/09/99 WU

R 19603/2760 (C

EXAMINER

HM22/0829

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ART UNIT	PAPER NUMBER

1638
DATE MAILED:

10
08/29/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/350,393

Applicant(s)

WU ET AL.

Examiner

Benzion

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 19-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Status of the Application

Claims 1-36 are currently pending. Claims 19-36 are withdrawn from further consideration as directed to a non-elected invention with traverse. Accordingly, claims 1-18 are the only claims under consideration herein.

Restriction/Election

Applicants' election under 35 U.S.C. § 121 to Group I, claims 1-18 with traverse is noted. Applicants argue that the inventions are closely related and would therefore command a common search. Applicants' arguments have been carefully considered and are not deemed persuasive. The different groups are separately classified and encompass patentably separate subject areas. Thus a search of more than one invention would entail an "undue burden" as the search for one would not be coextensive for any other.

This application contains claims 19-36 drawn to an invention non-elected with traverse in paper No. 9. A complete response to the final rejection must include cancellation of the non-elected claims or other appropriate action. (37 CFR 1.44) and MPEP §821.01.

Attention is directed to PTO form 948 regarding correction to drawings.

Applicant is required to submit drawing correction if response to this Office Action, however, formal correction to the noted defects can be deferred until the application is allowed by the examiner.

Detailed Action

35 U.S.C. § 112.

The following is a quotation of the first paragraph of 35 § U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 11 and 15 are rejected 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

It is apparent that plasmids pJS112, pJS21 and pJMOO1 are required to practice the claimed invention. As such they must be readily available or obtainable by a repeatable method set forth in the specification, or otherwise readily available to the public. If it is not so obtainable or available, the requirements of 35 USC 112, first paragraph, may be satisfied by a deposit said plasmids.

If a deposit is made under the terms of the Budapest Treaty, then an affidavit or declaration by Applicants, or a statement by an attorney of record over his or her signature and registration number, stating that the instant invention will be irrevocably and without restriction released to the public upon the

issuance of a patent, would satisfy the deposit requirement made herein. If a deposit has not been made under the Budapest Treaty, then in order to certify that the deposit meets the criteria set forth in 37 CFR 1.801-1.809, Applicant may provide assurance of compliance by affidavit or declaration, or by a statement by an attorney of record over his or her signature and registration number showing that:

- (a) during the pendency of the application, access to the invention will be afforded to the Commissioner upon request;
- (b) all restrictions upon availability to the public will be irrevocably removed upon granting of the patent;
- (c) the deposit will be maintained in a public depository for a period of 30 years, or 5 years after the last request or for the effective life of the patent, whichever is longer;
- (d) a test of the viability of the biological material at the time of deposit (see 37 CFR 1.807); and
- (e) the deposit will be replaced if it should ever become in viable;

35USC 112, second paragraph.

Claim 4 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 presents an open Markush group and as such is improper. Attention is directed to the limitation "and a gene for regulating the expression of stress-responsive genes." Markush groups by their nature are closed and recite specific elements, which comprise a group of art related molecules.

Claims 1-18 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Reference to an "ABRC unit" is both vague and indefinite as the term is undefined in the specification and does not appear to be common to the art. The specification defines the terms ABA abscisic acid and ABARES- as response elements (see page 5 for example) and references an ABA responsive complex at page 6, line 30+ as comprising an ABA element coupled to a Gbox (ABRE3) coupled to a CE1 and further that this comprise a minimal unit of 49 bps to provide ABA response. Furthermore, at page 11, reference is made to an ABRC unit from Barley as corresponding to the HVA22 or HVA1 genes without reference to how, if any, these prior art genes correspond to the varying definitions of what constitutes an ABRC unit. Accordingly, the terms presented as so vague and indefinite as to preclude further examination of the invention to the extent that prior art cannot be properly applied. In this regard attention is directed to *In re STEELE, MILLS, AND LEIS*, 134 USPQ 292 (CCPA 1962), in which the Court stated.

Our analysis of the claims indicates that considerable speculation as to meaning of the terms employed and assumptions as to the scope of such claims were made by the examiner and the board. We do not think a rejection under 35 U.S.C. 103 should be based on such speculations and assumptions. There is an admission by the board that the affidavits submitted show superiority of "samples of appellants' polymers employed in these tests over samples of the polymers of the reference patent." Before it can be held that the claims on appeal cover "a wide range of compositions," it is essential to know what the claims do in fact cover. As we have previously indicated, our analysis of the claims leaves us

in a quandary as to what in fact is covered by them. We think the examiner and the board were wrong in relying on what at best are speculative assumptions as to the meaning of the claims and basing a rejection under 35 U.S.C. 103 thereon.

In this regard, applicants are advised to revise the claims to the extent that they meet the requirements of 35USC 112, second paragraph, and that new matter must be avoided.


Summary

No claim is allowed.

Inquires

Any inquiry concerning this or earlier communication from the examiner should be directed to Gary Benzion, Ph.D. whose telephone number is (703) 308-1119. The examiner can normally be reached on Monday-Friday from 7:00 AM to 3:30 PM. Any inquiry of a general nature or relating to the status of this application should be directed to the Patent Analysts, Gwendolyn Payne, whose telephone number is (703) 305-2475. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Benzion
8/27/01


GARY BENZION, Ph.D.
Acting Supervisory Patent Examiner
GROUP ART UNIT 1638